REMARKS

As amended the application contains claims 1-9.

Support for newly added claims

Support for newly added claim 6 can be found in the specification as filed on pages 15 and 16 particularly with respect to the definition of Y and Y'.

Support for newly added claim 7 can be found in the specification as filed on pages 15 and 16.

Support for newly added claim 8 can be found in the specification as filed on page 6 at line 27.

Support for newly added claim 9 can be found in the specification as filed on page 7 at line 4.

Priority

In response to paragraphs 1 and 2 of the last office action, a certified translation of the priority document is filed concurrently herewith.

Rejections under 35 USC 102/103 over Azechi

The rejection in paragraphs 3-5 of the last office action over United States Patent Application Publication Number 2002/0032270 A1 (Azechi) is traversed but is rendered moot by the filing of the certified translation of the priority

document. The earliest effective date of Azechi as prior art is July 11, 2001, the date on which Azechi was filed in the USA. As shown on the certified translation of the priority document, the instant case is entitled to a filing date in Japan of January 5, 2001, a date more than six months prior to the earliest effective date of Azechi. Azechi is not prior art under either 35 USC 102 or 103. Since Azechi is not prior, art any rejection over Azechi is rendered moot.

Rejections under 35 USC 102/103 over Fujiki

The rejection in paragraph 6 of the last office action over United States Patent Application Publication Number 2002/0028335 A1 (Fujiki) is traversed but is rendered moot by the filing of the certified translation of the priority document. The earliest effective date of Fujiki as prior art is July 11, 2001, the date on which Fujiki was filed in the USA. As shown on the certified translation of the priority document, the instant case is entitled to a filing date in Japan of January 5, 2001, a date more than six months prior to the earliest effective date of Fujiki. Fujiki is not prior art under either 35 USC 102 or 103. Since Fujiki is not prior art, any rejection over Fujiki is rendered moot.

Rejections under 35 USC 102/103 over Morita

The rejection of the last office action of claims 1-3 in paragraph 7 as obvious over US patent 5,530,075 (Morita) over US patent 5,714,265 (Meguriya) is traversed. Morita neither discloses nor suggests either the claimed subject matter or the features of the present invention. The deficiencies of Morita are not supplied by Meguriya.

More specifically, according to the present invention, blending an organopolysiloxane composition of the heat curing type with an organic compound or organosilicon compound containing an amount of epoxy group to give an epoxy equivalent of 100 to 5,000 g/mol and at least one aromatic ring in a molecule affords a silicone rubber adhesive composition which is firmly bondable to thermoplastic resins. When this silicone rubber adhesive composition is molded and joined with a thermoplastic resin, there is obtained an integrally molded article in which the silicone rubber is firmly bonded to the thermoplastic resin. Even under brief curing conditions using an injection molding technique, the silicone rubber adhesive composition develops a sufficient bonding force to the thermoplastic resin. The integrally molded article of silicone rubber with thermoplastic resin can

be released from the metal mold in a practically acceptable way.

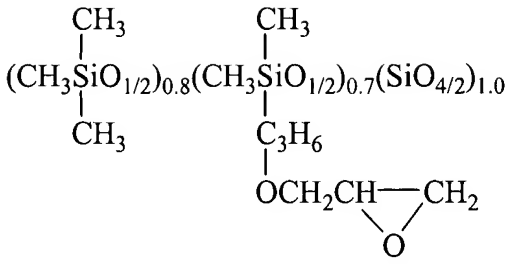
The feature of the invention is proved by Examples and Comparative Examples of the present specification.

Morita discloses a curable resin composition comprised of A) 100 parts by weight curable resin, and B) 0.1-500 parts by weight of an organopolysiloxane having organic groups that contain epoxy groups, which is expressed by the formula:

$$(R^2\overset{R^1}{\underset{R^1}{Si}}O_{1/2})_a(R^3\overset{R^1}{\underset{R^1}{Si}}O_{1/2})_b(SiO_{4/2})_c$$

wherein R^1 is a univalent hydrocarbon group excluding alkenyl groups, R^2 is a hydrogen atom or a univalent hydrocarbon group excluding alkenyl groups, R^3 is an alkoxysilylalkyl group or an organic group that contains epoxy groups, a is 0 or a positive integer, b is a positive integer and c is a positive integer, where a/c has the value of 0 to 4, b/c has the value of 0.05 to 4 and (a+b)/c has the value of 0.2 to 4. The curable resin composition of the instant invention has superior flowability that produces a hardened resin with superior flexibility and adhesion.

Morita discloses the following organopolysiloxane in Preparation Example 1:



as a suitable component (B).

However, the use of the above organopolysiloxane does not give good selective bonding strength to various substrates, as proved by the concurrently filed document entitled "Declaration" signed on 30 May 2003, by the inventor, hereinafter referred to as the "Azechi Declaration".

Morita therefore fails to disclose or suggest that blending an organopolysiloxane composition of the heat curing type with an organic compound or organosilicon compound containing an amount of epoxy group to give an epoxy equivalent of 100 to 5,000 g/mol and at least one aromatic ring in a molecule affords a silicone rubber adhesive composition which is firmly bondable to thermoplastic resins, in spite of the fact that the integrally molded article of silicone rubber with thermoplastic resin can be released from the mold in a practically acceptable way.

Morita furthermore fails to disclose or suggest that the cured product of the inventive silicone rubber adhesive

composition provides a greater bond strength to an organic resin or a thermoplastic resin than a metal mold for molding the silicone rubber adhesive composition.

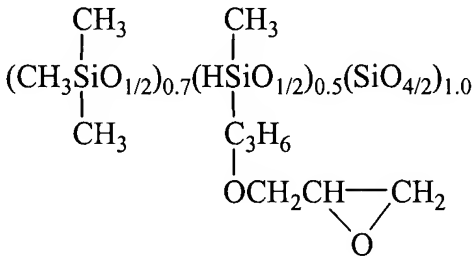
The attention of the Examiner is respectfully invited to the fact that there are no Preparation Examples in Morita disclosing an organic compound or organosilicon compound having an epoxy equivalent of 100 to 5,000 g/mol and containing **at least one aromatic ring** in a molecule.

More specifically, Morita discloses the formula:

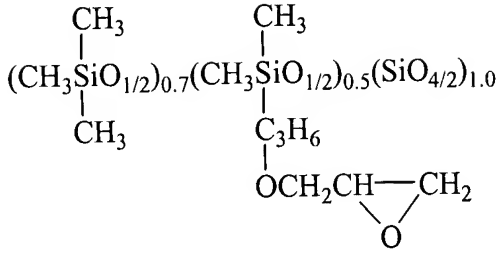
$$(R^1{}_2R^2SiO_{1/2})_a(R^1{}_2R^3SiO_{1/2})_b(SiO_{4/2})_c.$$

However, **in all of Synthetic Examples and Examples of Morita, all of R^1 and R^2 are methyl. There are no silicone resins in which R^1 is phenyl and/or R^2 is SiH group**.

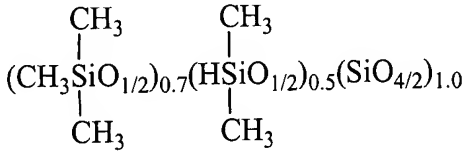
Morita Preparation Example 3 discloses, at column 7, line 55, a siloxane of the formula:



However, this formula is incorrect. The resulting organopolysiloxane should be:



because the organopolysiloxane is obtained by reacting



with an excess amount of allyl glycidyl ether.

Moreover, the definition that component (C) is the organosilicon compound having a linear or cyclic siloxane structure as in newly added claim 6 further distinguishes the present invention from Morita which uses a resin having tetra functionally branched siloxane structure shown as $[SiO_{4/2}]$. Component (C) as defined by newly added claims 6 and 7 do not contain such a tetra functionally branched siloxane structure and therefore further distinguish over Morita.

At any event, the feature of the present invention, especially the selective bonding strength according to the present invention (i.e., the cured product of the silicone rubber adhesive composition has a greater bond strength to an organic resin than to metal or metal mold) is not expected from Morita, even if Morita is combined with Meguriya which

also fails to disclose or teach either the subject matter or the features of the claimed invention.

Allowable Subject Matter

The indication in paragraph 8 of the last office action of the presence of allowable subject matter in dependent claim 5 is acknowledged with appreciation. That claim has now been rewritten in independent form and is clearly allowable.

The reasons for allowability in paragraph 9 of the last office action are amongst the many reasons that exist.

Conclusions

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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